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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/898,150 | 07/03/2001 | Dietmar Uhde | PD000032 | 2593 |

7590 01/25/2006

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| EXAMINER |
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ORTIZ CRIADO, JORGE L

| ART UNIT | PAPER NUMBER |
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2656

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,150

Applicant(s)

UHDE ET AL.

Examiner

Jorge L. Ortiz-Criado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-28 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-28 and 30-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 22-28 and 30-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
2. Claims 22, 31 and 38 each recites the limitation “wherein the identification data of the optical disc medium is read before fine focusing adjustment or track regulation are adjusted”.

The Examiner cannot assert where in the disclosure including the specification this limitation is found. The Examiner cannot find any fine focusing adjustment performed and/or reading the identification data before this process of fine focusing adjustment.

In page 5 of the specification, recites “It is particularly advantageous if the content of the BCA data area is read as the identification information which individually identifies the respective recording medium, since this BCA data area comprises relatively coarse structures and can be read very easily by a read apparatus. For this purpose, all that is necessary is for the objective lens of the playback apparatus to be coarsely focused by the focus regulation”. But, in this portion only describes the advantage of the known BCA information, which comprises a

coarse structure and the objective lens need to be coarsely focused. There is absolutely no “fine focusing adjustment” found or described in the disclosure, and or support for this limitation as claimed. Hence, the limitation is considered new matter.

3. Claims 22-28 and 30-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 22, 31 and 38 each recites the limitation “wherein the identification data of the optical disc medium is read before fine focusing adjustment or track regulation are adjusted”.

But, as described in the disclosure the examiner cannot find how the applicant is performing such reading before a fine focusing adjustment. The portions of the specification relating some sort of reading of an identification information with some sort of adjustment is found on page 5 of the specification, where states that the advantageous if the content of the BCA data area is read as the identification information which individually identifies the respective recording medium, since this BCA data area comprises relatively coarse structures and can be read very easily by a read apparatus and that is necessary is for the objective lens of the playback apparatus to be coarsely focused by the focus regulation.

The specification does not provide any description or explanation to how or where this fine focusing adjustment is made, as to enable one of an ordinary skill in the art how to make or use the invention as claimed.

Dependent claims 23-28, 30 and 32-27 fall together accordingly.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 22-24, 27-35 and 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Bakx U.S. Patent No. 5,072,435.

Regarding claim 22, Bakx discloses a method for reducing an initialization time of an apparatus for reading from and/or writing an optical recording medium, said optical recording medium having identification information data which enables the identification of the optical recording medium individually among at least optical recording media of the same type (See Abstract; col. 1, line 35 to col. 2, line 57), comprising the steps of:

reading the identification information data of an optical recording medium inserted into said apparatus to identify said optical recording medium (See col. 5, lines 31-43; Figs. 2,10);

determining if adjustment values associated with parameter values for reading from and writing to the identified optical recording medium are accessibly stored for said apparatus (See col. 5, lines 31-43; Figs. 2,10);

in response to identifying that adjustment values for said apparatus, setting control and regulating circuits of said apparatus in accordance with stored adjustment values (see col. 5, lines 45-48; Figs. 2,10) and

in response to determining that adjustment values for said apparatus are not accessibly stored, initializing said apparatus to determine respective adjustment values for the control and regulating circuits of said apparatus such that said apparatus is able to optimally read from and write to the identified optical recording medium, and respectively storing said determined adjustment values for said apparatus and the corresponding identification data of said identified optical recording medium (see col. 5, lines 48-61; Figs. 2,10)

wherein the identification data of the inserted optical recording medium is read by said apparatus before “fine focusing or track regulation are adjusted” (see col. 5, lines 31-61; col. 6, lines 34-35; steps A11, A12, A14 **are performed in a non-optimum conditions** , therefore these steps are performed before optimum adjustments which requires fine adjustments to the focusing)

Regarding claims 23 and 33, Bakx discloses wherein the adjustment values for said apparatus are stored in a storage means for storing at least said determined adjustment values for said apparatus (see col. 5, lines 48-61; Fig. 1, ref# 12)

Regarding claims 24 and 34, Bakx discloses wherein said storage means comprises a “non-volatile” memory (see col. 5, lines 48-61; Fig. 1, ref# 12)

Regarding claim 27, Bakx discloses wherein the identification data of the optical recording media comprises first data identifying said optical recording medium as one of a

plurality of recording types and second data specific to only the respective optical recording medium. (See col. 2, lines 1-21; col. 5, line 31-61; Fig. 2,10)

Regarding claim 28, Bakx discloses wherein the adjustment values for said apparatus comprise at least values for the focus, tracking or gain of components of said apparatus for optimally reading from and writing to an inserted optical recording medium (see col. 3, line 39 to col.. 4, line 2; see col. 5, lines 31-61; col. 6, lines 34-35)

Regarding claim 30, Bakx discloses wherein the respective identification data of the optical recording media is recorded on the optical recording media such that the identification data "is able to be read" by a reading means of said apparatus before the reading means reaches an optimal focus position (see col. 3, line 39 to col.. 4, line 2; col. 5, lines 31-61; col. 6, lines 34-35; step A11, A12, A14 are performed in a non-optimum conditions /"a read readiness state")

Regarding claim 31, apparatus claim 31 is drawn to the apparatus that performs the corresponding method claimed in claim 22. Therefore apparatus claims 31 correspond to method claim 22 and are rejected for the same reasons of anticipation as used above.

Regarding claim 32, Bakx discloses wherein said detection means comprise at least one of a read and a **read/write** means (See col. 3, lines 21-22 Fig. 1, ref#3)

Regarding claim 35, Bakx discloses wherein said storage means comprises at least one of a non-volatile memory of the apparatus and a non-volatile data carrier provided externally to the apparatus (see Fig. 1, ref# 12)

Regarding claim 37, Bakx discloses wherein a method/apparatus for reducing an initialization time of an apparatus for reading from and/or writing an optical recording mediums having identification information data which enables the identification of the optical recording medium individually among at least optical recording media of the same type, as outlined above with claim 31. Bakx does not expressly disclose the use of DVD-ROM discs as optical recording media. However, an optical recording media encompass DVD-ROM discs, because DVD-ROM discs are optical recording media having identification information data.

Regarding claim 38, claim 38 recites limitations similar to the claim 22 above and is rejected for the same reasons of anticipation as used above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bakx U.S. Patent No. 5,072,435 in view of Scibora U.S. Patent No. 6,366,544

Bakx discloses all the limitations based on claim 22, as outlined above. Bakx further discloses wherein a storage means is accessible by the apparatus. But Bakx does not expressly disclose an external storage means,

However this feature is well known in the art as evidenced by Scibora, which discloses a storage means carrier provided externally to an apparatus, and in that the content of the file of said storage means is accessible by said apparatus (See col. 3, lines 9-11; col. 4, lines 21-29; Fig. 1).

Therefore it would have been obvious to one with ordinary skill in the art at the time of the invention to include a storage means provided externally to the apparatus and in that the content of the file of said storage means is accepted into a memory which is provided in the apparatus, because by providing the external storage means allows update by downloading to the memory in the apparatus, with other content files which identifies the recording medium and enable reading the recording medium by the information content downloaded to the memory of the apparatus, as suggested by Scibora.

7. Claims 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bakx U.S. Patent No. 5,072,435 in view of Shim U.S. Patent No. 6,608,804.

Bakx discloses all the limitations based on claims 22 and 31 as outlined above. Bakx discloses where the location for recording the identification data depends on the type of the

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recording media used. But Bakx does not expressly disclose wherein a Burst Cutting Area “BCA” of the optical recording media comprises the identification data of the optical recording media.

However, the features of a “BCA” data area used to obtain identification information or other types of information is well known in the art and is normally provided for identification and/or authorization of discs and is evidenced by Shim.

Shim discloses a method for quickly producing read or write readiness of an apparatus for reading from or writing to an optical recording medium, the recording medium having identification information items which individually identify the recording medium individually among recording media of the same type (i.e. same types: “Optical Media”, among the same type DVD, CD, CD-ROM, DVD-ROM etc.), which includes of a Burst Cutting Area “BCA” comprising an identification information data to rapidly and accurately performs discrimination of the different discs.

It would have been obvious to one with ordinary skill in the art to include the identification information as in “BCA” identification in order to quickly and accurately performing the identification as suggested by Shim, and further since the BCA signal level is larger in amplitude and longer in cycle as compared with the pit signal of the program area of the recording medium, the BCA signal is easily distinguished at the time of reproducing by a simple circuit, furthermore the BCA would also aids in piracy protection as well know in the art.

Note: Furthermore applicant is admitting that *“the invention can generally be applied to optical recording media which can be distinguished using individually stored features or identification information items. This is true, in particular, of DVD-ROM media, since the latter*

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often have a "BCA code" ("Burst Cutting Area") which is individually allocated for each medium or each recording medium. After the uniform production of a series of discs, the "Burst Cutting Area" is applied by a burning operation into a specific area of the individual disc. This BCA data area is normally provided for identification and authorization of the disc.

Since this BCA data area uniquely identifies a disc, this BCA data area can be used for individual recognition of the corresponding disc" (page 3, line 28 to page 4, line 4 of the specification).

Assuming arguendo that the above is not applicant's admission of prior art, the features are taught by the Shim reference as used above.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. U.S. Patent No. 6,519,213, which discloses a recording disk with a bca area and method and apparatus for reading from the disk, and where the bca data is read without track regulation.

Response to Arguments

Applicant's arguments filed 11/09/2005 have been fully considered but they are not persuasive.

Applicants argues that Bakx reference absolutely does not teach, disclose or suggest, "the identification data of the inserted optical recording medium is read by said apparatus before fine focusing or track regulation", "determining if adjustments values associated with parameters

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values for reading from and writing to the identified optical recording medium are accessibly stored for said apparatus”, because Bakx reference discloses several examples of adjustment parameters (i.e. intensity, field strength, pulse width, speed) and where NONE of the these parameters influences the ability to read, and do not even exist as adjustable parameters in reading as recognized by an expert in the field.

And, where Bakx absolutely does not teach, disclose or suggest, the Applicant’s invention, which upholds adjustments parameters like focus gain, focus offset, track gain, track, offset, and HF gain as taught in the Applicant’s Specification, that directly influence READING, such that teachings of Bakx teach away from the Applicant’s claimed invention.

The Examiner cannot concur with Applicant.

During patent examination, the pending claims are given their broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000); See In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997)

Bakx teaches wherein the identification data of the inserted optical recording medium is **read** by said apparatus before said apparatus reaches “a read readiness state/Optimum conditions” (see col. 5, lines 31-61; col. 6, lines 34-35; step A11, A12, A14 are performed in a **non-optimum conditions** /before read readiness state, time while the adjustments using the parameters have NOT being made, NOT Optimally Adjusted hence no “fine” focusing are adjusted etc.)

Bakx discloses and teaches reading from and writing the identified optical recording medium which specifically discloses a READ/WRITE head # 3 as in Fig. 1, and where a write

means (i.e. elements # 3, #8 in Fig. 1) are Optimally Adjusted depending on the Identification data Read, determining if adjustments values associated with parameters values for reading from and writing to the identified optical recording medium are accessibly stored for said apparatus, in that, as acknowledged by Applicant, Bakx teaches several adjustments parameters (i.e. intensity, field strength, pulse width, speed) and at **Very Least** the Adjustment parameter of light Intensity, directly influences the ability to READ as well as of WRITE, and it would be understood to one of ordinary skill in the art, see for example references made of record in 04/07/2004, 12/23/2004, Massakawa U.S. Patent No. 5,155,719, U.S. Patent No. Suzuki 4,989,195), hence would have been understood also to an expert in the field as well.

Furthermore, prior art reference teaches away from claimed invention if it suggests that developments flowing from its disclosures are unlikely to produce objective of invention, and what reference teaches person of ordinary skill in art is not limited to what reference specifically “talks about” or what is specifically “mentioned” or “written” in reference. What a reference teaches a person of ordinary skill is not, as “Applicant’s expert” appears to believe, limited to what a reference specifically “talks about” or what is specifically “mentioned” or “written” in the reference. Syntex (U.S.A.) LLC v. Apotex Inc., 74 USPQ2d 1823 (CA FC 2005); *In re Gurley*, 27 F.3d 551, 553 [31 USPQ2d 1130] (Fed. Cir. 1994).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L. Ortiz-Criado whose telephone number is (571) 272-

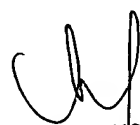
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7624. The examiner can normally be reached on Mon.-Thu.(8:30 am - 6:00 pm),Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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1/20/06